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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,515

09/01/2006

Seiichi Akagi

MIYOSH0008

6701

24203 7590 03/30/2009  
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EXAMINER

PAK, HANNAH J

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/598,515	<b>Applicant(s)</b> AKAGI ET AL.	
	<b>Examiner</b> Hannah Pak	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. All outstanding paragraph rejections, except for those maintained below, are withdrawn in light of applicants' amendment/remarks filed on 12/15/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action. The amendment to claims 1, 2, 11, 13, 14, 16-18, 21, and 25-26 have been amended to improve grammar, punctuation, and/or clarity, and not for a reason related to patentability (see Page 11 of the Applicants' Remarks).
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12, 18-20, 22-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikezawa et al. (US 2003/0201548) in view of Nakamura et al. (JP 05-283560).

The rejection is adequately set forth in Pages 4-6 of Office action mailed on 08/13/2008 and is incorporated here by reference.

5. Claims 13-17, 21, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikezawa et al. (US 2003/0201548) in view of Nakamura et al. (JP 05-283560) as applied to claims 1-12, 18-20, 22-24, and 26 above, and further in view of Isshiki et al. (US 6,040, 395) and applicant's submission.

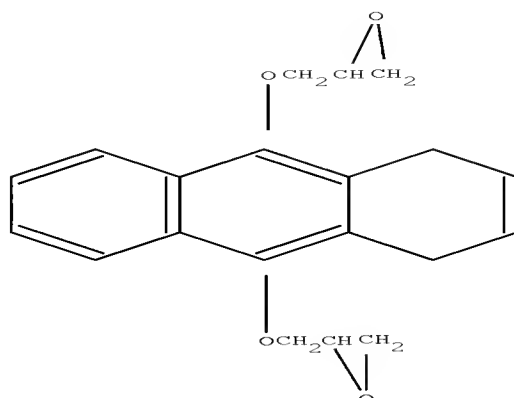
The rejection is adequately set forth in Pages 6-7 of Office action mailed on 08/13/2008 and is incorporated here by reference.

### ***Response to Arguments***

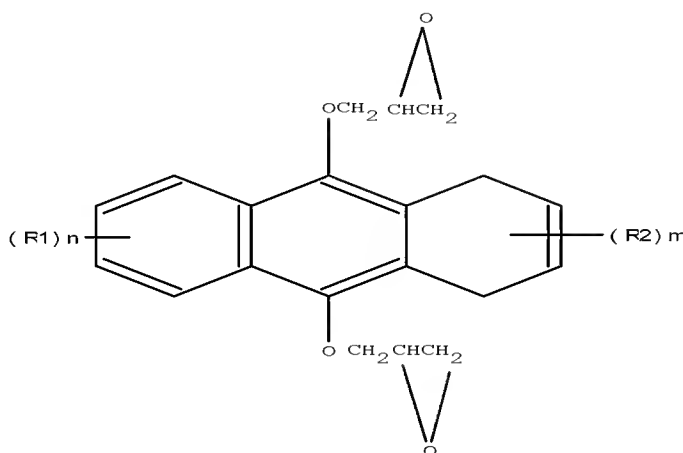
6. Applicants' arguments filed 12/15/2008 have been fully considered but they are not persuasive. Specifically, the applicants argue **A)** Nakamura document, Isshiki Patent, and the AAAPA does not teach or suggest the claimed compound contained in the epoxy resin (A) (see Pages of the Applicants' Remarks). The applicants also **B)** argue that the compound taught by Nakamura document is synthesized differently from the applicants, showing that Nakamura's compound is difficult to make on an industrial level (Page 15 of the Applicants' Remarks). The applicants further argue that the Nakamura document does not teach or even suggest the use of their compound as a flame retardant (see Page 16 of the Applicants' Remarks).

With respect to argument **A)**, as mentioned in the prior office action, Nakamura disclose a semiconductor device using the epoxy compound having the following formula below (Paragraph 43, Formula 9):

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This formula corresponds to formula 1 in claim 1:



wherein when  $n = 0$ ,  $R^1$  or  $R^2$  groups would not be necessary. Thus, Nakamura does teach the claimed compound. Nakamura also discloses this epoxy resin is useful for sealing (or encapsulating) material (Paragraphs 1-2), which has the same purpose (a sealant epoxy-resin molding material) as the claimed compound.

With respect to argument **B)**, the claims do not require the process of making the compound, and therefore, the references of the record do not have to teach such process. The applicants claim a product, not the process. The claims also do not require the compound to be used as a flame-retardant, and thus, the references of the record do not have to teach using the compound as the flame-retardant.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hannah Pak whose telephone number is (571) 270-5456. The examiner can normally be reached on Monday - alternating Fridays (7:30 am - 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hannah Pak  
Examiner  
Art Unit 1796

/HP/

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796